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09/389,565

09/03/1999

DAVID M. NEVILLE, JR.

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08/14/2008

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EXAMINER

EWOLDT, GERALD R

ART UNIT

PAPER NUMBER

1644

MAIL DATE

DELIVERY MODE

08/14/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



Art Unit: 1644

### DETAILED ACTION

1. Claims 31-33, 37, 39, and 44-47 are pending and being acted upon.

2. Applicant's terminal disclaimer and remarks filed 5/08/08 are acknowledged. In view of Applicant's terminal disclaimer the previous double patenting rejection over U.S. Patent No. 6,632,928 has been withdrawn. Additionally, in view of Applicant's election of claims drawn to nucleic acids in the 10/296,085 application, the previous double patenting rejection over that application has also been withdrawn.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 39, 44, 46, and 47 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1 and 6 of U.S. Patent No. 7,288,254. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the '254 patent recite a method which renders the claimed method obvious.

Applicant's arguments, filed 5/08/08, have been fully considered but are not found persuasive. Applicant argues that the claims in the patent have the same effective filing date

Art Unit: 1644

and, additionally, that a 2 way obviousness analysis is required.

Regarding the effective filing date, it is unclear what effect the filing date has on a double patenting rejection. Regarding a 2 way obviousness analysis, Applicant has not demonstrated that Applicant could not have filed the claims in a single application and that there was an administrative delay as is required for the requirement of a 2 way obviousness analysis.

5. Claims 31-33, 37, and 45 are allowed.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Gerald Ewoldt whose telephone number is (571) 272-0843. The examiner can normally be reached Monday through Thursday from 7:30 am to 5:30 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eileen O'Hara, Ph.D. can be reached on (571) 272-0878.

8. **Please Note:** Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-

Application/Control Number: 09/389,565

Page 4

Art Unit: 1644

free).

/G.R. Ewoldt/

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Primary Examiner

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